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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,130	01/09/2001	Benjamin Englander	2200600.131-US1	6441
28089	7590	11/12/2009	EXAMINER	
WILMERHALLE/NEW YORK 399 PARK AVENUE NEW YORK, NY 10022			NGUYEN, THONG Q	
ART UNIT	PAPER NUMBER			
	2872			
NOTIFICATION DATE	DELIVERY MODE			
11/12/2009	ELECTRONIC			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/757,130	<b>Applicant(s)</b> ENGLANDER, BENJAMIN
	<b>Examiner</b> Thong Nguyen	<b>Art Unit</b> 2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

- 1) Responsive to communication(s) filed on 05 May 2009 and 17 July 2009.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 and 9-16 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 2,3 and 10-16 is/are rejected.  
 7) Claim(s) 1-4-7 and 9 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/5/2009 has been entered.

### ***Response to Amendment***

2. The present Office action is made in response to the amendments filed on 5/5/2009 and 7/17/2009.

3. It is noted that in the amendment of 7/17/09, applicant has provided a list of claims. There is not any argument being provided in the amendment filed on 7/17/09. Thus, the claims as provided in the amendment of 7/17/2009 are used in the examination and the arguments as provided in the amendment of 5/5/2009 are used as applicant's arguments with respect to the art rejections.

### ***Claim Objections***

4. Claims 1-7 and 9-16 are objected to because of the following informalities.

Appropriate correction is required.

a) In claim 1: on line 7, the feature thereof "the contoured outer surface of the mirror element being affixed to the mirror pole" is misdescriptive of the invention as taught in the specification, in particular, in page 3, line 6 and shown in figure

1. Applicant should note that the specification discloses that the mirror element (10) is affixed to the mirror pole (12). The specification does not disclose that the contoured outer surface of the mirror element being affixed to the mirror pole as claimed. Should the terms thereof "the contoured outer surface of the mirror element being affixed to the mirror pole and used" appeared on lines 7-8 of the claim be changed to -- the mirror element being affixed to the mirror pole and the contoured outer surface of the mirror element being used--? See also present claim 10, on line 6 and claim 16, on line 5.

It is also suggested that the term "the" used in the phrase "the school bus" appeared on each of lines 10 and 14 be changed to --said-- for the purpose of maintain the consistence of claimed language in the claim. See lines 5, and 8-9 of the claim.

b) The suggestions as set forth in element a) above are also raised to claim 9. In particular, should the terms thereof "the contoured outer surface of the mirror element being affixed to the mirror pole and used" appeared on line 8 of the claim be changed to --the mirror element being affixed to the mirror pole and the contoured outer surface of the mirror element being used--?

It is also suggested that the term "said" used in the phrase "said school bus" appeared on each of lines 9 and 10 be changed to --the-- for the purpose of maintain the consistence of claimed language in the claim. See lines 6, 11, and 15 of the claim.

- c) In each of claim 10 and claim 16: The following corrections are suggested to each claim.

In claim 10, on line 8 and in claim 16, on line 7, "the bottom half" should be changed to --a bottom half--; and in claim 10, on line 12 and claim 16, on line 11, "an" should be changed to --said-- or --the--. See claim 10 on line 8 and claim 16 on line 7.

- d) The remaining claims are dependent upon the objected base claims and thus inherit the deficiencies thereof.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 2 and 11 are rejected under 35 U.S.C. 112, first paragraph, for the following reasons.

- a) Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a mirror having a treated portion to reduce glare which treated portion encompasses the top one third of the mirror surface, see specification, page 2 (line 9) and page 4 (lines 11-12), does not reasonably provide enablement for a mirror having a treated portion to reduce glare which treated portion encompasses ***less than*** one third of the mirror surface (examiner's emphasis). The specification does not enable any person skilled in the art to which it pertains, or with

which it is most nearly connected, to make the invention commensurate in scope with these claims.

b) Claim 11 is rejected under 35 USC 112, first paragraph for the similar reason as set forth in element a) above.

7. Claims 3 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a) Claim 3 is rejected under 35 USC 112, first paragraph because the specification does not disclose a mirror having a treated portion which satisfies both the feature thereof "the contoured outer surface...horizontal direction" (claim 1, lines 11-17) and the feature thereof "the portion treated to reduce glare is located in spaced relation to and not in contact with any portion of the peripheral edge of the mirror surface" (claim 3, lines 1-3).

*Applicant should note that as clearly recited in base claim 1, lines 14-16, the treated portion is measured along a vertical direction, beginning from the uppermost position on the contoured mirror surface and ending above a straight notional line which bisects the mirror surface in a horizontal direction. The uppermost position on the contoured mirror surface as disclosed in the specification, page 3, lines 19-21 and figs. 2 is point 30 which is on the peripheral*

*edge 50. With such a teaching then the treated portion cannot locate in two different locations as recited in the device claimed in dependent claim 3.*  
*Applicant should also noted that while page 4, lines 19-23 and fig. 4 discloses a position of the treated portion of the mirror; however, the embodiment as described in mentioned page and figure 4 does not meet the features recited in claim 1, lines 14-16.*

b) Claim 12 is rejected under 35 USC 112, first paragraph for the similar reason as set forth in element a) above.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 10-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 10 is rejected under 35 USC 112, second paragraph for the following reason. The claim recites the limitation "the bottom half of said contoured outer mirror surface" in line 13. There is insufficient antecedent basis for this limitation in the claim. Applicant should note that the bottom half portion recited on line 8 of the claim is of the mirror element, not the contoured outer mirror surface.

b) Claim 16 is rejected for the similar reason as set forth in element a) above.

c) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

***Allowable Subject Matter***

10. Claims 1, 4-7, 9-10 and 13-16 would be allowable if rewritten or amended to overcome the objections and/or rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
11. The following is a statement of reasons for the indication of allowable subject matter: The cross-view mirror assembly installed on a vehicle wherein the mirror of the assembly has a contoured outer mirror surface of a convex, generally dome shaped mirror surface and having an upper portion is treated with an antiglare material to reduce glare as claimed is readable over the prior art provided by stout (U.S. Patent No. 4,822,157) and Falge (U.S. Patent No. 1,768,354); however, the device as claimed in each of the independent claims 1, 9, 10 and 16 is allowed because applicant has submitted sufficient Declaration and written papers to show the commercial success, of the device claimed.

***Conclusion***

12. The publication No. 20070030582 is cited as of interest in that it discloses a cross-view mirror assembly having similar structure as that claimed in the present application. However, the publication and its correspondent U.S. application have a filing date later than that of the present application.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thong Nguyen/

Primary Examiner, Art Unit 2872